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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/572,972

09/13/2006

Katsuhiko Imai

483/9-2222

3733

28147 7590 05/12/2009
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EXAMINER

BARTOSIK, ANTHONY N

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|------------------------------------|--|
| Office Action Summary | Application No. 10/572,972 | Applicant(s) IMAI ET AL. | |
| | Examiner ANTHONY N. BARTOSIK | Art Unit 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/22/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/14/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a First Action Non-Final Rejection, sent in response to the Applicants' submission of March 22, 2006.

Information Disclosure Statement

Applicants are reminded of their duty under 37 CFR 1.56 to disclose information that is material to the patentability of the application. The Examiner requests that the Applicant's submit any further information that is material in addition to the Imai reference, a co-inventor in the present application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 sets forth a screw hole and then later claims a supporting hole, which appear to be referencing the same element. Language that twice claims an element renders the claims indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai (JP 2001262713).

6. In Re claim 1, Figure 1 of Imai discloses the claimed invention except for multiple bores and lag screws. It would have been obvious to one skilled in the art at the time of the invention to include a second lag screw and bore as claimed as a mere duplication of parts producing no new or unpredictable results. MPEP 2144.04(VI.)(B.)

7. In Re claims 5, 6, and 11, Figure 1 of Imai discloses the claimed invention.

8. In Re claims 7 and 8, the limitations of the claim describing how the boss is formed are product-by-process limitations. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

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though the prior product was made by a different process. See MPEP 2113 and 2173.05(p). Here the boss is capable of being formed as claimed.

9. In Re claims 9 and 10, Figure 1 of Imai discloses the claimed invention except for the particular features included on the sleeve as set forth in claims 9 and 10. It is well known in the art to include sleeves that utilize a mechanism to secure the sleeve against a bolt for maintaining a contacting relationship, transmission of torque, or otherwise. For example a hole and set screw is often employed to carry out this function. Therefore, it would have been obvious to include a pin or slit and rod in the sleeve of Imai. Such a modification would be obvious as a use of a known technique to a known device yielding a predictable result. Additionally, the limitations as claimed would be an obvious variant from the base claim as well as the invention as described in the prior art.

10. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai (JP 2001262713) in view of Uhl (U.S. 2,092,684).

11. In Re claims 2 and 3, Imai discloses the claimed limitation except for the thorny ring surrounding the lag screw. Figure 1 of Uhl teaches the use of a lag screw to transmit load from one structure to another. It would have been obvious to one skilled in the art at the time of the invention to include a thorny ring to assist in transmitting load

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from one structure to another. Furthermore, the inclusion of a thorny ring does not yield any new or unpredictable results.

12. In Re claim 4, the above combination discloses the claimed limitations except for the united body. It would have been obvious to one skilled in the art at the time of the invention to unite the body with the thorny ring, which is to make the parts integral, as a matter of obvious engineering design choice. MPEP 2144.04(V.)(B.).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY N. BARTOSIK whose telephone number is (571)270-3112. The examiner can normally be reached on M-F 7:30-5:00; E.D.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

Anthony Bartosik
Examiner
Art Unit 3635